UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DTW Nov-08

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

COPY MAILED

NOV 13 2008

OFFICE OF PETITIONS

In re Patent No. 6445800	:	
Issue Date: 09/03/2002	:	
Application Number: 09/489774	:	ON PETITION
Filing Date: 01/24/2000	:	
Attorney Docket Number:	:	
277897US6DIV	:	

This is a decision on the "PETITION UNDER 37 C.F.R. §1.181(A)(2)," filed on June 23, 2008, which is treated as a petition under 37 CFR 1.182, and 37 CFR 1.183, requesting that a a terminal disclaimer recorded in prior-filed Application No. 07/600,818, filed on October 22, 1990, which issued as U.S. Patent No. 5,640,458, on June 17, 1997, be withdrawn or nullified with regard its effect on the term of instant patent.

The petition is **dismissed**.

Petitioner requests that the Director nullify any effect of the terminal disclaimer filed on June 13, 1994, in the above-referenced, prior-filed application, No. 07/600,818 (hereinafter "the '818 application") on the subject patent, No. 6,445,800 (hereinafter "the '800 patent"), which issued from Application No. 09/489,774 (hereinafter "the '774 application").

It is noted that petitioner states:

> Initially, Patentee respectfully request that 37 C.F.R. § 1.182(f) be suspended. Rule 182(f) indicates that a petition not filed within two months of the action or notice from which relief is sought may be dismissed as untimely. However, under 37 C.F.R. § 1.183, the Director, or the Director's designee, may suspend or waive a Rule in the event of extraordinary circumstances or when justice requires. Patentee submits that the present situation is such a case.

Petitioner's argument has been, considered, but is not persuasive.

Preliminarily, it is noted that MPEP 1490 states

> While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "un-happy circumstance" in In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed **before the patent issues**. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).
>
> The mechanisms to correct a patent – Certificate of Correction (35 U.S.C. 255), reissue (35 U.S.C. 251), and reexamination (35 U.S.C. 305) – are **not** available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. **As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public**, particularly where the public interest is not protected in some manner – e.g., intervening rights in the case of a reissue patent. See, e.g., Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935).
>
> (emphasis added)

As such, petitioner must show why the terminal disclaimer filed in the '818 application, to which the subject application claims benefit under 35 U.S.C. § 120, should not be given full effect in the '800 patent which issued from the '774 application.

At the outset, a decision is being issued in Patent No. 5,640,458 (hereinafter "the '458 patent"), concerning the petition to withdraw the terminal disclaimer. The reasons why the terminal disclaimer will not be withdrawn or nullified in the '818 application have been explained in the decision issued in the '458 patent. As such, the sole issue at hand is whether the effect of the terminal disclaimer filed in the '818 application

can be nullified or withdrawn with regard to the '800 patent, which issued from the '774 application, an application claiming benefit under 35 U.S.C. § 120 to the '818 application.

The terminal disclaimer filed on June 13, 1994, in the '818 application states that petitioner "hereby disclaims the terminal twenty-six (26) months of any patent granted on said Application Serial No. 07/600,818 or on any application which is entitled to the benefit of the filing date of said Application No. Serial No. 07/600,818 under 35 U.S.C. 120."

Accordingly, in claiming the benefit under 35 U.S.C. 120 of the '818 application in the '774 application, petitioner acquiesced to any and all limitations on the patent term of any patent issuing from the '774 application, as imposed by the terminal disclaimer filed in the '818 application.

As stated above, as a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner – e.g., intervening rights in the case of a reissue patent. See, e.g., Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935).

As discussed in the decision on petition in the '458 patent, the balance of equities does not merit the Director overruling the well-settled public policy precluding restoration to the patent owner of something that has been freely dedicated to the public in favor of correcting, after issuance of the patent and an extended period of delay. The showing of record is that petitioner did not file the petition to withdraw the terminal disclaimer in the '818 application until an extended period after the '458 patent had issued, and has not provided an adequate explanation of neither the delay in filing the petition, nor a sufficient reason why the Director should grant the requested relief under 37 CFR 1.182.

Further, considered under 37 CFR 1.183, petitioner's argument is not well taken. As stated previously, 37 CFR 1.183 provides that in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.

The facts presented on the record do not establish an extraordinary situation. Petitioners have not established any special circumstances or equities that would require suspension of the rules in the interests of justice. It is noted that petitioner has not identified a particular rule the waiver of which would provide the relief requested.

Lastly, 35 U.S.C. § 120 states that an application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. Accordingly, to the extent that the term of the '800 patent is limited by the terminal disclaimer filed in the '818 application, and the subject patent claims benefit of the '818 application under 35 U.S.C. 120, the claim of benefit is statutory. Accordingly, the USPTO simply lacks the authority or discretion to relax any requirement of law. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); A. F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977), (since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute).

As such, to the extent that the '458 patent which issued from the '818 application, to which the subject application claims benefit under 35 U.S.C. 120, is subject to the terminal disclaimer at issue, any patent which issued from an continuing application filed under 35 U.S.C. 120, which claims the benefit of the '818 application, is, by statute, subject to all of the limitations which apply to the '818 application, the '458 patent, and any applications for patent claiming benefit under 35 U.S.C. § 120 thereto.

Accordingly, the petition is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquires should be directed to the undersigned at 571.272.3231.

D Wood

Douglas Wood
Senior Petitions Attorney
Office of Petitions

Conferee: Anthony Knight, Supervisor